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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,751	10/01/2001	Emmanuelle Belli	13833.0008	3618

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EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,751

Applicant(s)

BELLI, EMMANUELLE

Examiner

San-ming Hui

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-35, 37-39 and 41-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-35, 37-39, and 41-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2004 has been entered.

Claims 26-35, 37-39, and 41-48 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 26-35, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midha et al. (USPN 5,986,015).

Midha et al. (USPN 5,986,015) teaches a cosmetic composition comprising polymers of monomers such acrylic acid, methacrylic acid, acrilamide (see col. 6, line 63 to col. 7, line 47). Midha et al. (USPN 5,986,015) also teaches a hair styling gel comprising 2.5 weight percent of Graft copolymer 1.2 (which comprises methacrylic acid and tert-butyl acrylate), 0.5 weight percent Carbomar 940 (a thickening agent), see particularly col. 17 lines 23-26 and col. 19, example 17. Midha et al. (USPN 5,986,015) further teaches the addition of optional ingredients such as xanthan gum (a polymeric thickener) to its cosmetic hair composition, see col.16, lines 14-26. Midha et al. (USPN 5,986,015) teaches that the concentration of optional ingredients will typically and collectively range from 0.05% to 30% by weight of the composition, see particularly col. 14, lines 36-46. Midha et al. (USPN 5,986,015) that the cosmetic composition is suitable for application to hair, see col. 11 line 59 in particular.

Midha et al. does not expressly teach the composition have the herein viscosity. Midha et al. does not expressly teach the employment of the herein claimed branched block copolymer and the herein claimed thickeners in a cosmetic hair gel composition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ specifically the claimed branched block copolymer and the thickeners claimed herein in a cosmetic hair gel composition and adjust the viscosity to the herein claimed range.

One of ordinary skill in the art would have been motivated to employ the herein claimed branched block copolymer and the thickeners in a cosmetic hair gel composition. The herein claimed polymer and the herein claimed thickeners are taught by examiner's cited prior art to be used in cosmetic hair gel compositions. Incorporating these well-known hair gel components for formulating the herein claimed cosmetic hair gel composition would be obvious as considered within the purview of skilled artisan, absent evidence to the contrary. Furthermore, the optimization of result effect parameters (e.g., viscosity of the composition) is obvious as being within the skill of the artisan. Please note that the viscosity of the composition depends upon many factors such as the molecular weight of the polymers and the concentration of the polymer. Adjusting the concentration, thereby the viscosity, of the composition is within the purview of skilled artisan, absent evidence to the contrary.

Examiner notes that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristic of the claimed invention. For the purpose of searching for and applying prior art under 35 USC 102 and 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising" See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). When an applicant contends that additional steps or

materials in the prior art are excluded by the recitation of "consisting essentially of,"
applicant has the burden of showing that the introduction of additional steps or
components would materially change the characteristics of applicant's invention. *In re*
De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*,
12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although consisting
essentially of' is typically used and defined in the context of compositions of matter, we
find nothing intrinsically wrong with the use of such language as a modifier of method
steps. . . [rendering] the claim open only for the inclusion of steps which do not
materially affect the basic and novel characteristics of the claimed method. To
determine the steps included versus excluded the claim must be read in light of the
specification. . . . [I]t is an applicant's burden to establish that a step practiced in a prior
art method is excluded from his claims by 'consisting essentially of' language.") (See
MPEP 2111.03).

Claims 41-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Midha et al. (USPN 5,986,015) in view of Merck (Merck Index, 11th ed., 1989,
monograph 4486).

Midha et al. (USPN 5,986,015) teaches a cosmetic composition comprising
polymers of monomers such as acrylic acid, methacrylic acid, acrilamide (see col. 6, line
63 to col. 7, line 47). Midha et al. (USPN 5,986,015) also teaches a hair styling gel
comprising 2.5 weight percent of Graft copolymer 1.2 (which comprises methacrylic acid
and tert-butyl acrylate), 0.5 weight percent Carbomar 940 (a thickening agent), see

particularly col. 17 lines 23-26 and col. 19, example 17. Midha et al. (USPN 5,986,015) further teaches the addition of optional thickening agents such as xanthan gum (a polymeric thickener) to its cosmetic hair composition, see col.16, lines 14-26. Midha et al. (USPN 5,986,015) teaches that the concentration of optional ingredients will typically and collectively range from 0.05% to 30% by weight of the composition, see particularly col. 14, lines 36-46. Midha et al. (USPN 5,986,015) that the cosmetic composition is suitable for application to hair, see col. 11 line 59 in particular.

Midha et al. does not expressly teach the composition have the herein viscosity. Midha et al. does not expressly teach the employment of the herein claimed branched block copolymer and the herein claimed thickeners as guar gum in a cosmetic hair gel composition.

Merck Index teaches the guar gum is a well-known thickening agent useful in cosmetic, pharmaceutical and food industry, especially for pharmaceutical jelly composition (See the USE Section).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ specifically the claimed branched block copolymer and guar gum in a cosmetic hair gel composition and adjust the viscosity to the herein claimed range.

One of ordinary skill in the art would have been motivated to employ the herein claimed branched block copolymer and guar gum in a cosmetic hair gel composition. The herein claimed polymer is taught by examiner's cited prior art to be used in cosmetic hair gel compositions. Incorporating these well-known hair gel components for

formulating the herein claimed cosmetic hair gel composition would be obvious as considered within the purview of skilled artisan, absent evidence to the contrary. In addition, guar gum is also known to be useful as a thickening agent for jelly composition. Incorporating well-known thickening agents, such as guar gum, in the composition of Midha et al. would be considered obvious as being selecting from the obvious alternatives. Furthermore, the optimization of result effect parameters (e.g., viscosity of the composition) is obvious as being within the skill of the artisan. Please note that the viscosity of the composition depends upon many factors such as the molecular weight of the polymers and the concentration of the polymer. Adjusting the concentration, thereby the viscosity, of the composition is within the purview of skilled artisan, absent evidence to the contrary.

Response to Arguments

Applicant's arguments filed September 25, 2003 averring the cited prior art's failure to provide any motivation to prepare the herein claimed hydrophobic/hydrophilic graft copolymer have been considered, but are not found persuasive. Examiner notes that the instant case is not at all similar to that of *In re Baird*. There is no specific compound taught in *In re Baird*; whereas the instant case, the specific monomers are taught in the cited prior art as the preferred monomers. As discussed in the previous action, Midha et al. clearly teaches the herein claimed monomers such as acrylic acid, methacrylic acid, acrilamide (see col. 6, line 63 to col. 7, line 47). Secondly, the number of species in *In re Baird* is of 100 million whereas the number of the species in

the instant case is 6. Midha et al. also teaches the method of making graft polymers can be hydrophilic or hydrophobic backbone grafted with either hydrophilic or hydrophobic side chain (See col. 5, lines 15-25). Absent evidence to the contrary, one of ordinary in the art would have employ the monomers of Midha et al. to form the specific graft polymers herein and employing them into cosmetic hair composition as taught in Midha et al. since selecting the herein claimed hydrophilic/hydrophobic graft polymers would be simply considered as choosing from the obvious alternatives by one of ordinary skill in the art.

Applicant's also remarks in response filed September 25, 2003 that the size of the genus taught in Midha being large cannot be support an obviousness rejection. In response to the remarks, examiner notes that it is the size of the genus being large as the reason for both *In re Baird* and *In re Jones* that the court reversed the decision of the Broad. However, in the instant case, the number of possible combination is not big. It is considered that Midha has envisioned all six possible combinations of graft polymer to be useful in Midha's invention. Thus, selecting one particular combination of graft polymer over the others would be obvious as being selecting from the obvious alternatives.

Applicant's arguments filed September 25, 2003 averring the viscosity differences between non-cellulosic thickener and cellulosic thickener have been considered, but are not found persuasive. It is not clear why the differences in viscosity among different thickeners rendering the invention unobvious. As the matter of fact, it is well-expected that different thickeners will have different viscosity. Combining and

employing various amount of the thickeners is reasonably expected to be useful in optimizing the viscosity of the final composition, absent evidence to the contrary.

Applicant's arguments filed September 25, 2003 with regards to the recitation "consisting essentially of" have been considered, but are not found persuasive. When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. According to the applicants, the basic and novel characterisitc of the instant composition is disclosed. However, there is no evidence of record to show that the addition of various substances taught in the prior art would change such characteristics. Therefore, the rejection is still considered proper.

Applicant's arguments filed September 25, 2003 averring the cited prior art's failure to teach the motivation to incorporate guar gum. Absent evidence showing the criticality of using guar gum specifically, one of ordinary skill in the art would considered substituting or incorporating guar gum into the composition of Midha obvious as being selecting from the obvious alternatives.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



San-ming Hui
Patent Examiner
Art Unit 1617